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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,887	04/16/1999	WARREN S. WILCOX	354533-00201(346327	4136
37509	7590	03/07/2005	EXAMINER	
DECHERT LLP P.O. BOX 10004 PALO ALTO, CA 94303			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 03/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/292,887

Applicant(s)

WILCOX ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) of 15 Feb 2005
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed with an amendment on 28 January 2005, and reinforced in a telephone interview on 17 February 2005, are persuasive with respect to the rejections of claims 23-49. An interview summary is attached. However, the claims were found to be obvious over prior art made of record by the examiner on 5 April 2001. A new non-final rejection follows. The previous objection to claims 47-49 is also maintained.

***Claim Objections***

2. Claims 47-49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims add only nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph.
3. US patents are granted for inventions within the technological arts. Claims 47-49 add a limitation as to the kind of purchases, i.e., "purchases normally made each period of time by the credit card holder". Since the parent claims are already limited to the genus "all purchases made by the credit card holder", claims 47-49 add a specie that does not constitute a technological further limitation to the invention. That is, since the invention already claims the technology to accommodate "all purchases", no further technology would be required to accommodate any specie of said genus.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 23-31, 35-39 and 45-49 are rejected under 35 U.S.C. 103(a) as being obvious over Borowsky (non-patent literature entitled "Wells Fargo's credit card is a natural advantage",

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made of record 5 April 2001) in view of Wells Fargo (non-patent literature entitled "Wells Fargo links its plastic with mortgages", made of record 5 April 2001).

6. Borowsky teaches (independent claim 36) a method for providing credit card incentive payments, comprising: establishing a credit card account for a credit card holder having an account at the mortgage department of Wells Fargo, which reads on particular lending institution, for a mortgage, which (for a fixed rate) reads on an installment loan with a cost that requires a fixed periodic equal-sized payments made by the credit card holder to retire the loan; accumulating the total value of all purchases made by the card holder using the credit card during a period of time; calculating an installment loan benefit amount based on the accumulated value of all purchases; transferring the installment loan benefit amount to particular lending institution, so as to reduce the cost of the loan.
7. Borowsky does not teach that the credit card account is established on a credit card issuer computer system. Because computerization was common and efficient for administering credit card accounts, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Borowsky that the credit card account is established on a credit card issuer computer system. Accordingly, Borowsky also teaches independent claims 23 and 45 inherently.
8. Borowsky does not teach applying the installment loan benefit amount, as an additional payment, against the outstanding principal on the installment loan account. Wells Fargo teaches that the rebates can be used to get a lower interest rate, which reads applying the installment loan benefit amount, as an additional payment, against the outstanding principal on the installment loan account. Consider a \$100,000 mortgage at 10%, and at a reduced rate of 9%, over 30 years. The monthly payments are respectively \$833.33 and \$750.00. The first payment for the 10% note pays down the principal by \$44.24. (That is the total payment minus \$833.33 interest due.) However, the 9% note pays down the principal by \$54.62, \$10.38 more than the 10% note. This \$10.38 is the installment loan benefit amount, applied as an additional payment, against the outstanding principal on the installment loan account. Because Wells Fargo describes the same program as Borowsky does, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Wells Fargo to those of Borowsky.

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9. Neither reference teaches applying the program to an existing mortgage. Because it would help retain mortgage customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add existing mortgages to the teachings of Wells Fargo and Borowsky.
10. Borowsky does not teach determining if the credit card account is in good standing and if there is an outstanding balance on the credit card holder's installment loan account. Because it is good practice to determine if a credit card account is in good standing (i.e., not in default of its terms) before paying a rebate on the activity in said account, and to verify that a loan has not been paid off before making a payment, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these limitations to the teachings of Borowsky.
11. Similarly Borowsky does not teach (claims 24, 37 and 46) determining if the loan has been refinanced. Because it is good practice to verify that a loan has not been paid off before making a payment, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add determining if the loan has been refinanced to the teachings of Borowsky.
12. Borowsky also teaches claim 39. Wells Fargo teaches claim 28 inherently.
13. Neither reference teaches (claims 25, 26 and 27) that the benefit amount is transferred by wire and/or check. Because these are common instruments each useful in some circumstances, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add transfer of the benefit amount by wire and/or check to the teachings of Borowsky.
14. Neither reference teaches (claims 29-31, 35 and 38) that the payment period is one year. Because some customers may prefer a longer period, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add one year to the payment period teachings of Borowsky and Wells Fargo.
15. Borowsky inherently teaches (claims 47-49) that at least some of the credit card purchases are purchases normally made each period of time by the credit card holder. Borowsky teaches rebates based on credit card purchases without limitations. There is no suggestion to exclude purchases normally made each period of time.

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16. Claims 32 and 40 are rejected under 35 U.S.C. 103(a) as being obvious over Borowsky and Wells Fargo and further in view of in view of Fernandez-Holmann. Neither Borowsky nor Wells Fargo teach that the rebate percentage may vary depending on the amount of purchases charged to the credit card. Fernandez-Holmann teaches that the rebate percentage may vary depending on the amount of purchases charged to the credit card (col. 5 lines 63-65). Because it would encourage use of the credit card, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Fernandez-Holmann to the teachings of Borowsky and Wells Fargo.
17. Claims 33, 34 and 41-44 are rejected under 35 U.S.C. 103(a) as being obvious over Borowsky and Wells Fargo and further in view of in view of Simpson. Neither Borowsky nor Wells Fargo teaches that the benefit amount is based on the value of interest charged. Simpson teaches that the benefit amount is based on the value of interest charged (col. 1 lines 46-58). Because it would make the reference invention more attractive to some customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Simpson to the teachings of Borowsky and Wells Fargo.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
19. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.<sup>1</sup> The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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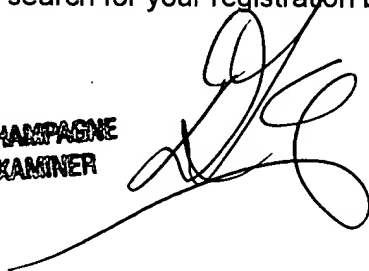
<sup>1</sup> 571-272-6724 after the middle of April 2005.

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**



Donald L. Champagne  
Primary Examiner  
Art Unit 3622

21 February 2005